

09/993,333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Larry W. Oberley et al.
Serial No.: 09/993333
Filed: November 14, 2001
Title:

Examiner: James Schultz
Group Art Unit: 1635
Docket: 875.042US1

REDUCTION OF ANTIOXIDANT ENZYME LEVELS IN TUMOR CELLS
USING ANTISENSE OLIGONUCLEOTIDES

PATENT

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Restriction Requirement mailed December 30, 2002, wherein the Examiner asserts that Applicants are required to elect one antisense sequence from claim 20. Claim 20 is directed to an oligonucleotide comprising an antisense nucleic acid sequence that specifically binds to a nucleic acid encoding an antioxidant enzyme start codon, wherein the sequence is SEQ ID NO:1, 2 or 3. Applicants provisionally elect with traverse SEQ ID NO:2. Reconsideration of the Restriction Requirement in view of the remarks presented below is respectfully requested.

The Restriction Requirement is traversed on the basis that Restriction Requirements are optional in all cases. M.P.E.P. § 803. In addition, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it may include claims to distinct or independent inventions. M.P.E.P. § 803. Applicants submit that the number of sequences recited in claim 20 is sufficiently few and so closely related that a search of the whole group can be made without serious burden. M.P.E.P. § 803.02. Evidence that SEQ ID NOS: 1-3 are closely related is provided in the specification at page 4, lines 1-11 and in Figure 1, wherein it is disclosed that each of SEQ ID NO:1-3 are oligonucleotide sequences of 20 nucleotides in length that overlap the start codon of human Manganese Superoxide Dismutase (MnSOD; SEQ ID NO:11). Further evidence that a search of SEQ ID NOS:1-3 is reasonable is provided at page 2 of the Restriction Requirement, wherein the Examiner states current Office policy allows up to at least ten independent and distinct nucleotide sequences to be examined in a single application, citing 37 C.F.R. § 1.141 and

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M.P.E.P. §§ 803.04 and 2434 (emphasis added). Therefore, it is Applicants' position that the search and examination of each of SEQ ID NOs:1-3 can be made without serious burden.

Further, it should be noted that because claim 20 is a Markush style claim, if the elected specie, *i.e.*, SEQ ID NO:2, is found to be patentable, the Examiner is required to extend the search to the extent necessary to determine patentability of the non-elected species. M.P.E.P. 803.02.

Applicants respectfully request a favorable examination of the merits of this patent application. The Examiner is invited to telephone Applicants' attorney (612-373-6961) to facilitate prosecution of this application. Please charge any additional fees deemed necessary to Deposit Account 19-0743.

Respectfully submitted,


LARRY W. OBERLEY ET AL.,

By their Representatives,

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Date 30 January 2003

By


Ann S Viksnins
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on this 30 day of January, 2003.

Candis B. Buending

Name


Signature